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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,718	03/31/2004	Masaru Yamashita	12401/5	8718

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BRINKS HOFER GILSON & LIONE
Suite 3600
NBC Tower
P.O. Box 10395
Chicago, IL 60610

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,718

Applicant(s)

YAMASHITA, MASARU

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4 IDS's</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-34, drawn to a transfer tape and a transfer tool, classified in class 428, subclass 343.

2. II. Claim 35, drawn to a method of transferring an adhesive film onto a targeted object, classified in class 156, subclass 60+.

3. The inventions are distinct, each from the other because:

4. Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not related as product and process of use because the particles required for method claim 35 (Group II) are considerably narrower in scope than the particles which are set forth in independent claim 1 directed to a transfer tape and in claim 18 directed to a transfer tool, the latter also requiring at least the presence of a dispenser. That is, the claims are directed to two groups of articles (Group I) or to a method of use (Group II) requiring a patentably distinct second article from either of those in Group I.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Tadashi Horie on December 21, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-34. Affirmation of this election must be made by applicant in replying to this

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Office action. Claim 35 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. The disclosure is objected to because of the following informalities: More particularly, the comparisons set forth in Figures 1 and 2 contain several errors such as the presence of two "Working Example 4" which, however, have differing numerical values present for some of the variables. Additionally, applicant might desirably also wish to rearrange the manner in which the data has been presented in these two figures, such as presenting all the Working Examples before presenting any of the Comparative Examples.

Appropriate correction is required.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in claim 1 the method of contemplated usage "wherein" clause should have the phrase – suitable for being – inserted before "transferred" in line 4 of the claim, and in claim 18 there appears to be no positive connection between the dispenser and the transfer tape, i.e. the band-shaped ribbon; as it is now the claim appears to be a kit claim. Additionally, in claim 18, line 4 "the" should be –a-- as object lacks any sort of antecedent basis. In claims 6-8 and 23-25 "a" should be –the--, and in claims 11-13 and 28-30 proper Markush

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language should be used in place of "comprises". Additionally, there may be other translation related informalities and the like which applicant should correct.

10. Claims 1-3, 5-20 and 22-34 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. More particularly, Paragraph [0024] appears to teach that the weight percentage range of particles set forth in each of these claims is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP Patent Abstract Publication 2001-240812 taken in view of Derwent Abstract XP-002315710 of JP 61 066772 and for claims 18-34 in further view of Fischer, the latter cited as evidence of the state of the art. JP '812 discloses what appears to be a closely related pressure sensitive adhesive transfer tape having desirable cutting properties caused by the stringiness of the adhesive, wherein the adhesive contains a small particulate filler desirably having a particular size relationship with the particular adhesive layer thickness. Additionally, several members of the reference genus of desirable tape backing, i.e. ribbon, and also the desirable genres of adhesive

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compositions appear to be elements which applicant also utilizes in his disclosed transfer tape. The reference lacks a teaching of the desirability of using particles having the particular geometric characteristics which applicant employs as being particularly suitable for assisting in the cutting of the adhesive tape when in operation. The secondary reference, however, discloses a suitable genus of adhesive compositions having an overlapping range of particle amounts to applicant's preferred range and which teaches whisker and needle shaped particles such as applicant finds to be particularly useful as an adhesive filler in "tape" applications and the like. Accordingly, one of ordinary skill, motivated by an expectation of improved tape severability and the like would incorporate the filler particles of the secondary reference in place of the particles taught by XP '710 and thereby make the claimed genus of adhesive tapes. With respect to claims 18-34 Fischer is cited as evidence of the state of the art that film transfer apparatus i.e. a dispenser, is well known and is also capable of utilizing the claimed transfer tape in its dispenser type structure in a manner well known to one of ordinary skill. Other parameters that are not either expressly or inherently disclosed, such as the particular geometric structure of the particles and thicknesses of the various elements are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Rutz et al and the PG PUB of this application to Yamashita.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 – 272 -1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
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